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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,910	08/06/2001	Donald F. Gordon	60136.0091USC1	9300
94140 7590 07/22/2010 Merchant & Gould - Cox PO Box 2903 Minneapolis, MN 55402				
EXAMINER				
SHANG, ANNAN Q				
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07/22/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/922,910

**Applicant(s)**

GORDON ET AL.

**Examiner**

ANNAN Q. SHANG

**Art Unit**

2424

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/06/09 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

With respect to claims 1-19, rejected under 35 U.S.C. 103(a) as being unpatentable over **Knudson et al (6,016,141)** in view of **Hendricks et al (6,201,536)** and further in view of **Funahashi et al (5,691,915)**, Applicant amends claims, discusses the prior arts of record and the claimed invention and argues that the prior arts do not teach the claim limitations, i.e., fails to teach or suggest "...at least the providing a set of more than two on-demand programs..." that "...packaging the set into a subset having at least two on-demand programs of the set of on-demand programs..." etc., (see pages 5 of 9+ of Applicant's Remarks).

In responses, Examiner notes Applicant's arguments, however, the Examiner disagrees. Knudson teaches a server (MF/TV-DF 22/26) which provides a set of more

than two programs; packaging the set into a subset having at least two programs (fig.1 col.3, lines 9-21 and col.4, line 22-col.5, line 16), provides a user interface (figs.2 and 7-9, col.4, lines 16-col.5, line 16) for visually presenting a plurality of selectable objects for user selection including a first selectable objects for selecting real-time services to cause real time TV programs packages to be visually presented in response to selection of the first selectable menu by a user (figs.2-11, TV programs or pay programs, col.4, lines 8-15), where the real-time packages visually presented includes at least the subset of the at least two real-time TV programs as a subscription package (fig.6, col.4, line 38-col.5, line 30, line 52-col.6, line 57 and col.7, line 5-59). Knudson further determines if the programs are purchasable programs or part of one or more packages of pay programs and makes the programs available for impulse purchasing, immediately providing the selection in its entirety upon purchasing, and offers multiple packages of programs (near video-on-demand (NVOD), PPV, etc.,) to subscribers for purchasing on a daily, weekly, monthly, etc., basis, but fails to explicitly teach providing VOD or on-demand program services (fig.6, col.4, line 38-col.5, line 30, line 52-col.6, line 57 and col.7, line 5-59). Although Knudson teaches NVOD, PPV, IPPV, etc., Knudson is silent as to VOD. However, in the same field of endeavor, **Hendricks** discloses network manager for cable TV system Head-ends, which provides program packages, IPPV, NVOD, VVOD, VOD, etc., upon request from subscribers (figs.1-8, col.6, lines 56-65, col.4, line 1-14, col.8, line 8-col.9, line 38 and col.18, line 1-col.19, line 1+). Knudson as modified by Hendricks, fail to explicitly teach receiving a selection of the subset of the multiple programs and immediately providing the selection if a price of the selection is

zero (i.e. free or promotional programs). However, **Funahashi** discloses data transmission device which provides some pay programs free of charge (figs.1-2, col.1, line 47-col.2, line 1+, col.4, lines 13-52, col.5, line 9-col.6, line 1+). Hence, the 103(a) rejection is proper, meets all the claim limitations. The amendments to the claims necessitated the new ground(s) of rejection discussed below. **This office action is non-Final.**

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knudson et al (6,016,141)** in view of **Hendricks et al (6,201,536)** and further in view of **Funahashi et al (5,691,915)**

As to claim 1, note **Knudson** reference figures 1-11 discloses interactive TV program guide system with pay program package promotion and further discloses an interactive information distribution system containing service provider equipment and subscriber equipment (set-top terminal) that is interconnected by a communications network, the method of providing a subscription-on-demand service, comprising:

(MF/TV-DF 22/26) providing a set of more than two programs; packaging the set into a subset having at least two programs (fig.1 col.3, lines 9-21 and col.4, line 22-col.5, line 16).

Providing a user interface (figs.2 and 7-9, col.4, lines 16-col.5, line 16) for visually presenting a plurality of selectable objects for user selection including a first selectable objects for selecting real-time services to cause real time TV programs packages to be visually presented in response to selection of the first selectable menu by a user (figs.2-11, TV programs or pay programs, col.4, lines 8-15), where the real-time packages visually presented includes at least the subset of the at least two real-time TV programs as a subscription package (fig.6, col.4, line 38-col.5, line 30, line 52-col.6, line 57 and col.7, line 5-59).

Knudson teaches determines if the programs are purchasable programs or part of one or more packages of pay programs and makes the programs available for impulse purchasing, immediately providing the selection in its entirety upon purchasing, and offering multiple packages of programs (near video-on-demand (NVOD), PPV, etc.) to subscribers for purchasing on a daily, weekly, monthly, etc., basis, but silent as to **explicitly teach providing VOD or on-demand program services** (fig.6, col.4, line 38-col.5, line 30, line 52-col.6, line 57 and col.7, line 5-59).

However, **Hendricks** discloses network manager for cable TV system Head-ends, which provides program packages, IPPV, NVOD, VVOD, VOD, etc., upon request from subscribers (figs.1-8, col.6, lines 56-65, col.4, line 1-14, col.8, line 8-col.9, line 38 and col.18, line 1-col.19, line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Hendricks into the system of Knudson to include VOD service in addition to the other services, and offer purchasable promotional packages of VOD or on-demand programs to the subscriber on subscription basis.

Knudson as modified by Hendricks, fail to explicitly teach receiving a selection of the subset of the multiple programs and immediately providing the selection if a price of the selection is zero (i.e. free or promotional programs).

However, note that **Funahashi** discloses data transmission device which provides some pay programs free of charge (figs.1-2, col.1, line 47-col.2, line 1+, col.4, lines 13-52, col.5, line 9-col.6, line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Funahashi into the system of Knudson as modified by Hendricks to provide promotional programs and enable a user to select a desire program(s).

As to claims 2-7, Knudson further discloses where in response to selection of the selectable object representing the subset of the at least two programs causing subscription to the programming package, providing a time limited access period to the subset of at least two programs without incurring an additional fee, providing a time limited to access period to the subset of the at least two programs, subscription to the package at a predefined price, where the predefined price is one-time access fee and where the one-time access fee has time-limited period of access (fig.6, col.5, line 17-col.6, line 57 and col.7, line 5-59).

As to claims 8-19, Knudson further discloses programming package where the programming packages are arranged in a hierarchical package of programming, comprising multiple program packages including a top level package including all of the at least two programs and at least one particular package including only a portion of the at least on-demand programs, one particular package with respective portion of at least two programs, defined according to content categories comprises one or more sports, particular teams, etc., (col.6, line 5-35) to enable a user to select from an object representing a top level of hierarchical package programming, user defined program package to enable personal subscription service, causing subscription of the programming packages upon selections of the objects for predefined price for predefined time period and where the SOD service provides the content subsets at a predefined price for a predefined time period (fig.6, col.5, line 17-col.6, line 57 and col.7, line 5-59).

Knudson is silent as to explicitly teach providing VOD or on-demand program services.

However, **Hendricks** discloses network manager for cable TV system Head-ends, which provides program packages, IPPV, NVOD, VVOD, VOD, etc., upon request from subscribers as discussed above with respect to the rejection of claim 1.



***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, **call 800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

/Annan Q Shang/  
Primary Examiner, Art Unit 2424

**Annan Q. Shang.**